

REMARKS

It is respectfully submitted that the pending claims define allowable subject matter.

Claims 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by Correl *et al.* (United States Patent No. 5,133,491).

Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Correl *et al.* in view of Kolycheck *et al.* (United States Patent No. 5,574,104).

Claims 2 and 5-7 have been canceled without prejudice.

Claims 8-16 were withdrawn from consideration pursuant to the Applicants' electing with traverse the invention of claims 1-7.

Rejections Under 35 U.S.C. §102

The Applicants now turn to the rejection of claim 1 under 35 U.S.C. §102(b) as being anticipated by Correl *et al.* (U.S. Patent 5,133,491). Correl *et al.* discloses a substrate breaker that positively feeds substrate plates to a stick breaker where the sticks are broken from the plate. The sticks are fed upwardly to an elevated chip breaker where chips are broken from the sticks.

First, the Applicants submit that claim 1 has been amended to include a force gauge attached to the handle for measuring the force applied to the handle. The force gauge is supported by the specification. The specification discloses "a force gauge 290 is attached to the separating handle 250 to measure the force (F) applied to the handle 270, and in turn the edge portion 130" (see page 6, lines 9-11). The applicants submit that Correl *et al.* cannot anticipate or render obvious claim 1 because it does not disclose, teach or suggest, either alone or in combination with any of the other references of record, all of the elements recited in claim 1 as

amended herein. Specifically, Correl *et al.* does not disclose, teach or suggest “a force gauge attached to said handle for measuring the force applied to said handle.”

Correl *et al.* discloses the use of an “air cylinder” to rotate the “chip support down 15 degrees to a horizontal position” (col. 5, lines 3-10 of the specification, also see col. 6, lines 43-46 of the specification). As disclosed in Correl *et al.*, the “air cylinder” simply rotates the “chip support” from one fixed position to another. It does not measure the force applied to a handle and in turn applied to the edge of a chip.

Thus, because Correl *et al.* does not disclose, teach or suggest “a force gauge attached to said handle for measuring the force applied to said handle,” it cannot anticipate claim 1 or any of the remaining claims dependant thereon.

Rejections Under 35 U.S.C. §103

The Applicants now turn to the rejection of claims 3 and 4 under 35 U.S.C. §103(a) as being unpatentable over Correl *et al.* in view of Kolycheck *et al.* (U.S. Patent 5,574,104). Kolycheck *et al.* discloses an electro-static dissipative polymeric composition comprising a polyether polyurethane which can be blended with one or more base polymers.

The Applicants submit that Correl *et al.* and Kolycheck *et al.* do not render obvious dependent claims 3 and 4 because they do not disclose, teach or suggest, either alone or in combination with any of the other references of record, all of the elements recited in claims 3 and 4. As discussed previously, Correl *et al.* does not disclose, teach or suggest “a force gauge attached to said handle for measuring the force applied to said handle.” Likewise, Kolycheck *et al.* does not disclose, teach, or suggest all the elements recited in claim 1, specifically, Kolycheck *et al.* does not disclose, teach, or suggest “a force gauge attached to said handle for measuring the

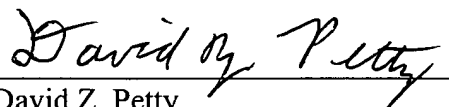
force applied to said handle.” Because neither Correl *et al.* nor Kolycheck *et al.* disclose this element, and because claims 3 and 4 depend from claim, the Applicants respectfully submit that these references do not provide a basis for rejecting claims 3 and 4.

Additionally, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference or to combine reference teachings. However, no reason has been shown why one of ordinary skill in the art would modify or combine Correl *et al.* and Kolycheck *et al.* to produce the claimed invention of claims 3 and 4. Therefore, the Applicants respectfully submit that Correl *et al.* in view of Kolycheck *et al.* does not render claims 3 and 4 obvious.

Conclusion

If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the Applicants.

Respectfully submitted,



David Z. Petty
Registration No. 52,119
Attorney for Applicants

McANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661

Telephone (312) 775-8000
Facsimile (312) 775-8100

Dated: 10/21/03